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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,715	12/20/2000	Robert H. Montgomery JR.	K-1775	7766

7590

03/10/2003

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EXAMINER

SINGH, SUNIL

ART UNIT

PAPER NUMBER

3673

DATE MAILED: 03/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/742,715

Applicant(s)

Montgomery Jr.

Examiner

Sunil Singh

Art Unit

3673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 12-24 is/are pending in the application.
- 4a) Of the above, claim(s) 1-5 and 17-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6, 9, 12, 15, 16, and 23 is/are rejected.
- 7) ☒ Claim(s) 7, 8, 13, 14, 22, and 24 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on Aug 13, 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 8 6) ☐ Other:

Art Unit: 3673

### **DETAILED ACTION**

Applicant argues that the restriction requirement mailed 10/29/02 was not proper because it was not burdensome for the examiner to search both the subcombination drawn to a sleeve and the combination drawn to a cutter tool assembly. It should be noted that restriction practices are not solely based on whether a search is burdensome or not. Applicant is entitled to one patent per invention. Furthermore, the examiner deems searching both inventions as burdensome. With regards to applicant's comment on the use of the subcombination, the examiner would like to point out to applicant that the subcombination of the sleeve can be used in other combinations which are different from his combinations. Another example would be the sleeve can be used as a member used in inserting an insert in a roller cone bit. The examiner deems the restriction proper; therefore, the restriction is final and claims 1-5 and 17-21 are hereby withdrawn from consideration.

### ***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-5, 17-21 are, drawn to a sleeve, classified in class 299, subclass 104.
  - II. Claims 6-9, 12-16, 22-24 are, drawn to a cutter tool assembly, classified in class 299, subclass 106.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions Group II and Group I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not

Art Unit: 3673

require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because it is evidenced by claims 9, 15 and 22-24 that a split sleeve is not required for patentability. The subcombination has separate utility such as a member used in inserting an insert in a roller cone bit.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

#### *Claim Objections*

4. Claims 9, 12-16, and 22-24 are objected to because of the following informalities:

Claim 9 "at least about an angle of about " is grammatically awkward.

Claim 12 does not further limit claim 9 since it also claims about 15 degrees.

Claim 13 should specify that a portion of the length of the holder bore is positioned aft of the vertical axis.

Claim 14 states that the bore positioned aft of the central vertical axis is 75%. It appears that applicant intends to state that 75% of the length of the bore lies aft of the central vertical axis.

Claims 15 and 23 are similarly objected as claim 13 above.

Claim 16 is similarly objected as claim 14 above.

Claim 22 is similarly objected as claims 13 and 14 above.

Art Unit: 3673

Claim 24 is similarly objected as claims 9 and 13 above. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claim 6 rejected under 35 U.S.C. 102(e) as being anticipated by Sollami (US 6371567).

Sollami discloses a non-rotatable protective sleeve (60) for a bit holder (61) on a cutting tool assembly comprising a partially split body element (see Figs. 3, 9, 10) including a forward portion adjacent an intermediate portion and a split portion (81,108) adjacent said intermediate portion, said body element adapted to be receivable in said bit holder.

Art Unit: 3673

7. Claims 9, 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Montgomery Jr. (US 4542943).

Montgomery Jr. discloses a cutter tool assembly for attachment to cutting tool machinery comprising a bit holder having a T-shaped key shank (4), a support block having a T-shaped groove (2) for receiving said bit holder T-shaped key shank, wherein said support block has symmetric top surfaces flanking said T-shaped groove (see Fig. 7), said support block having a central vertical axis, said symmetric top surfaces are oriented at an angle with respect to the horizontal plane so as to reduce rotation of the bit holder about said vertical axis. The angle is about 15 degrees.

8. Claims 15,16 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Salani (US 4621871, 5125720).

Salani '871 and 720 both disclose a cutter tool assembly comprising a cutting bit (34,12), bit holder (12,14), a support block (16, 16) wherein said support block has a central vertical axis, the bit holder includes a bore (see Fig. 1, 22) for receiving a shank of a cutting tool bit. The bit holder bore is positioned generally aft of the central vertical axis approximately 75%.

*Allowable Subject Matter*

Art Unit: 3673

9. Claims 7, 8 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
10. Claims 13, 14 would be allowable if rewritten to overcome the objection, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.
11. Claims 22 and 24 would be allowable if rewritten or amended to overcome objection, set forth in this Office action.

#### ***Response to Arguments***

12. Applicant's arguments with respect to claims 6, 15 and 23 have been considered but are moot in view of the new ground(s) of rejection.
13. Applicant's arguments filed 8/13/02 have been fully considered but they are not persuasive. Applicant argues that Montgomery '943 teaches an angle preferably 10 degrees while his claim 9 calls for about 15 degrees. It should be noted that the word "about" implies a range and 10 is considered to be "about" 15.

#### ***Conclusion***

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3673

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sunil Singh whose telephone number is (703) 308-4024. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Shackelford, can be reached on (703) 308-2978. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2168.



**HEATHER SHACKELFORD  
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SS

2/28/03